

REMARKS

This responds to the Office Action mailed on June 2, 2006.

Claims 2 and 13 are canceled. Claims 1 and 12 are amended. No claims are added. As a result, claims 1, 3-12, and 14-30 are now pending in this application.

For the convenience of the Examiner, Applicant's remarks concerning the claims will be presented in the same order in which the Examiner presented them in the Office Action.

Amendments to Claims 1 and 12

Claims 1 and 12 have been amended. No new matter has been introduced.

Claim 1 has been amended by inserting the phrase "wherein the channel is dimensioned to retain a fastener until the propulsion element is actuated", previously recited in claim 2. Support for this language may be found, for example, in claim 2 of the original disclosure.

Independent claim 12 has been amended by inserting the phrase "wherein the channel is dimensioned to retain a fastener until the air delivery infrastructure is actuated", previously recited in claim 13. Support for this language may be found, for example, in claim 13 of the original disclosure.

Rejection of Claims 1-3, 12-14, and 21 under 35 U.S.C. §102(b) as Anticipated by Pyatov

Claims 1-3, 12-14, and 21 were rejected under 35 U.S.C. §102(b) as being anticipated by Pyatov (U.S. 4,823,886).

The rule under 35 U.S.C. §102 is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP §2131.

Pyatov does not appear to disclose all of the structural elements recited in amended independent claims 1 and 12.

Regarding amended claim 1, Pyatov does not appear to disclose a nose having a channel wherein the channel is dimensioned to retain a fastener until the propulsion element is actuated. The passage in Pyatov (col. 2, line 33 through col. 3, line 59) referred to by the Examiner (Examiner's rejection, with regard to claim 2) does not appear to disclose a channel dimensioned to retain a fastener until the propulsion element is actuated. In Pyatov, a working tool 24 (FIG. 1) with a flange 25 is located in a central guide hole 22 and is restrained from falling out of the tool during operation by a holder 32 against which flange 25 rests (see col. 5, line 21). In Applicant's subject matter, a fastener is retained only until the propulsion element is actuated. Furthermore, Pyatov does not appear to disclose a fastener.

Regarding amended independent claim 12, Pyatov does not appear to disclose a nose coupled to the body and having a channel wherein the channel is dimensioned to retain a fastener until the air delivery infrastructure is actuated. As described above, in Pyatov, activation of the tool does not affect the retention of a fastener. In Applicant's claimed subject matter, a fastener is retained until the air delivery infrastructure is actuated.

For the above reasons, amended independent claims 1 and 12 should be found to be allowable over Pyatov, and Applicant respectfully requests that the rejection of claims 1 and 12 under 35 U.S.C. §102(b) as anticipated by Pyatov be withdrawn.

Claim 3, which depends from claim 1 and incorporates all of the limitations therein, is also asserted to be allowable for the reasons presented above.

Claims 14 and 21, which depend from claim 12 and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Rejection of Claims 23 and 24 under 35 U.S.C. §102(b)
as Anticipated by Suher

Claims 23 and 24 were rejected under 35 U.S.C. §102(b) as being anticipated by Suher (U.S. 5,417,294).

Suher does not appear to disclose all the structural elements recited in independent claim 23. For example, Suher does not appear to disclose a nose having a channel that is dimensioned to receive a fastener.

For the above reasons, claim 23 should be found to be allowable over Suher, and Applicant respectfully requests that the rejection of claim 23 under 35 U.S.C. §102(b) as anticipated by Suher be withdrawn.

Claim 24, which depends from claim 23 and incorporates all of the limitations therein, is also asserted to be allowable for the reasons presented above.

Rejection of Claims 4 and 15 under 35 U.S.C. §103(a)
as Unpatentable over Pyatov in view of Tanaka

Claims 4 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pyatov in view of Tanaka (U.S. 5,437,339).

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

Neither Pyatov nor Tanaka discloses all of the structural elements recited in independent claims 1 and 12, as amended. For example, neither Pyatov nor Tanaka discloses a nose having a channel dimensioned to retain a fastener.

The asserted combination of Pyatov in view of Tanaka fails to teach or suggest all of the claim limitations present in independent claims 1 and 12, so a *prima facie* case of obviousness has not been established. As was pointed out earlier, regarding the §102 rejection of the independent claims, Pyatov fails to disclose at least one element in each independent claim. Nor does the addition of Tanaka disclose the missing claim element.

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. MPEP §2143.03.

Claim 4 is dependent upon independent claim 1, which is asserted to be patentable over Pyatov in view of Tanaka for the reasons set forth above.

Claim 15 is dependent upon independent claim 12, which is asserted to be patentable over Pyatov in view of Tanaka for the reasons set forth above.

For the above reasons, claims 4 and 5 should be found to be allowable over any combination of Pyatov and Tanaka, and Applicant respectfully requests that the rejection of claims 4 and 5 under 35 U.S.C. §103(a) as unpatentable over Pyatov in view of Tanaka be withdrawn.

Rejection of Claims 5 and 16 under 35 U.S.C. §103(a)
as Unpatentable over Pyatov in view of Tanaka and further in view of McCloud

Claims 5 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pyatov in view of Tanaka and further in view of McCloud (U.S. 3,114,421).

Neither Pyatov nor Tanaka nor McCloud discloses all of the structural elements recited in independent claims 1 and 12, as amended. For example, neither Pyatov nor Tanaka nor McCloud discloses a nose having a channel dimensioned to retain a fastener.

The asserted combination of Pyatov in view of Tanaka and further in view of McCloud fails to teach or suggest all of the claim limitations present in independent claims 1 and 12, so a *prima facie* case of obviousness has not been established. As was pointed out earlier, regarding the §102 rejection of the independent claims, Pyatov fails to disclose at least one element in each independent claim. Nor does the addition of both Tanaka and McCloud disclose the missing claim element.

Claim 5 is dependent upon independent claim 1, which is asserted to be patentable over any combination of Pyatov, Tanaka, and McCloud for the reasons set forth above.

Claim 16 is dependent upon independent claim 12, which is asserted to be patentable over any combination of Pyatov, Tanaka, and McCloud for the reasons set forth above.

For the above reasons, claims 5 and 16 should be found to be allowable over any combination of Pyatov and Tanaka and McCloud, and Applicant respectfully requests that the rejection of claims 5 and 16 under 35 U.S.C. §103(a) as unpatentable over Pyatov in view of Tanaka and further in view of McCloud be withdrawn.

Rejection of Claim 10 under 35 U.S.C. §103(a)
as Unpatentable over Pyatov in view of Obergfell

Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Pyatov in view of Obergfell (U.S. 3,858,781).

The asserted combination of Pyatov in view of Obergfell fails to teach or suggest all of the claim limitations present in independent claim 1, so a *prima facie* case of obviousness has not been established. As was pointed out earlier, regarding the §102 rejection of the independent claims, Pyatov fails to disclose at least one element in each independent claim. Nor does the addition of Obergfell disclose the missing claim element.

Claim 10 is dependent upon independent claim 1, which is asserted to be patentable over Pyatov in view of Obergfell for the reasons set forth above.

For the above reasons, claim 10 should be found to be allowable over any combination of Pyatov and Obergfell, and Applicant respectfully requests that the rejection of claim 10 under 35 U.S.C. §103(a) as unpatentable over Pyatov in view of Obergfell be withdrawn.

Rejection of Claim 25 under 35 U.S.C. §103(a)
as Unpatentable over Suher in view of McCloud

Claim 25 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Suher in view of McCloud.

Neither Suher nor McCloud discloses all of the structural elements recited in independent claim 23. For example, neither Suher nor McCloud discloses a nose having a channel dimensioned to retain a fastener.

The asserted combination of Suher in view of McCloud fails to teach or suggest all of the claim limitations present in independent claim 23, so a *prima facie* case of obviousness has not been established. As was pointed out earlier, regarding the §102 rejection of the independent claims, Suher fails to disclose at least one element in each independent claim. Nor does the addition of McCloud disclose the missing claim element.

Claim 25 is dependent upon independent claim 23, which is asserted to be patentable over Suher in view of McCloud for the reasons set forth above.

For the above reasons, claim 25 should be found to be allowable over any combination of Suher and McCloud, and Applicant respectfully requests that the rejection of claim 25 under 35 U.S.C. §103(a) as unpatentable over Suher in view of McCloud be withdrawn.

Allowable Subject Matter

Claims 6-9, 11, 17-20, 22 and 26-30 were objected to as being dependent upon a rejected base claim, but they were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In view of Applicant's preceding remarks concerning the asserted patentability of independent claims 1, 12, and 23, Applicant does not wish to rewrite claims 6-9, 11, 17-20, 22 and 26-30 in independent form at this time, but Applicant respectfully reserves the right to do so at a later time.

Additional Elements and Limitations

Applicant considers additional elements and limitations of claims 1, 3-12, and 14-30 to further distinguish over the cited references, and Applicant reserves the right to present arguments to this effect at a later date.

Conclusion

Applicant respectfully submits that claims 1, 3-12, and 14-30 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602-298-8920) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

ALTON W. HEZELTINE

By his Representatives,
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, Minnesota 55402
(612) 373-6970

Date

September 5, 2006

By

Charles E. Steffey

Charles E. Steffey
Reg. No. 25,179

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 5th day of September 2006.

Chris Hammond

Name

Chris Hammond

Signature